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EXAMINER

CERVETTI, DAVID GARCIA

ART UNIT

PAPER NUMBER

2136

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/933,336

Applicant(s)

SALVATORI ET AL.

Examiner

David G. Cervetti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-22 are pending and have been examined.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 150 (page 15). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claims 12-13, and 18 are objected to because of the following informalities: "alpha-numeric **digits**", perhaps "characters" was intended, "alpha-numeric" refers to both letters (a-z, A-Z) and numbers (0-9), "digits" refers to numerals (0-9). Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1 and 3-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Marcus (US Patent 6,032,156).**

Regarding claim 1, Marcus teaches a method comprising: providing a digital video disc having data stored thereon configured to cause a digital video disc player to read the data in a manner sufficient to cause a video presentation to be displayed and to randomly generate a verification code from a plurality of alternative codes (column 2, lines 1-31, column 9, lines 22-67, column 10, lines 1-67, column 11, lines 1-67, column 12, lines 1-67); operating the digital video disc player in a manner to cause the video presentation to be displayed (column 10, lines 21-67, column 11, lines 1-67); operating the digital video disc player in a manner such that after at least part of the video presentation is displayed, the digital video disc player generates the verification code via the data of the digital video disc (column 10, lines 21-67, column 11, lines 1-67); using a client computer system to input the verification code via the Internet to a host computer system column 10, lines 21-67, column 11, lines 1-67).

Regarding claim 3, Marcus teaches wherein the step of using the client computer system to input the verification code to the host computer system comprises inputting the verification code to the host computer system in a manner to obtain a

benefit (column 2, lines 1-31, column 9, lines 22-67, column 10, lines 1-67, column 11, lines 1-67, column 12, lines 1-67).

Regarding claim 4, Marcus teaches wherein the data stored on the digital video disc is configured to enable the digital video disc player to read the data in a manner to cause a quiz to be displayed, the quiz comprising at least one question corresponding to the video presentation, the method further comprising operating the digital video disc player in a manner to cause the quiz to be displayed (column 2, lines 1-31, column 9, lines 22-67, column 10, lines 1-67, column 11, lines 1-67, column 12, lines 1-67).

Regarding claim 5, Marcus teaches wherein the data stored on the digital video disc is configured such that the digital video disc player generates the verification code after the at least one question is correctly answered, the method further comprising operating the digital video disc player in a manner to correctly answer the at least one question to thereby enable the digital video disc player to generate the verification code (column 2, lines 1-31, column 9, lines 22-67, column 10, lines 1-67, column 11, lines 1-67, column 12, lines 1-67).

Regarding claim 6, Marcus teaches a method comprising: providing a digital video disc to a client, the digital video disc having data stored thereon configured to cause a digital video disc player to read the data in a manner sufficient to cause a video presentation to be displayed and to randomly generate a verification code from a plurality of alternative codes (column 2, lines 1-31, column 9, lines 22-67, column 10, lines 1-67, column 11, lines 1-67, column 12, lines 1-67); operating a host computer system, the host computer system being configured to determine whether a code

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received from a client computer system is one of the plurality of alternative codes, the host computer system being accessible by the client using the Internet (column 10, lines 21-67, column 11, lines 1-67); prompting the client to input a code (column 10, lines 21-67, column 11, lines 1-67); operating the host computer system in a manner to determine whether the code input by the client comprises one of the plurality of alternative codes (column 10, lines 21-67, column 11, lines 1-67).

Regarding claim 7, Marcus teaches providing a benefit to the client if the host computer system determines that the code input by the client comprises one of the plurality of alternative codes (column 2, lines 1-31, column 9, lines 22-67, column 10, lines 1-67, column 11, lines 1-67, column 12, lines 1-67).

Regarding claim 8, Marcus teaches a method comprising: providing a digital video disc (column 2, lines 1-31, column 9, lines 22-67, column 10, lines 1-67, column 11, lines 1-67, column 12, lines 1-67); storing data on the digital video disc, the data being configured to cause a digital video disc player to randomly generate a verification code from a plurality of alternative codes (column 2, lines 1-31, column 9, lines 22-67, column 10, lines 1-67, column 11, lines 1-67, column 12, lines 1-67).

Regarding claim 9, Marcus teaches wherein: the step of providing a digital video disc comprises providing a plurality of digital video discs; the step of storing the data comprises storing the data on each of the plurality of digital video discs such that each of the plurality of digital video discs has identical data stored thereon (column 2, lines 1-31, column 9, lines 22-67, column 10, lines 1-67, column 11, lines 1-67, column 12, lines 1-67).

Regarding claim 10, Marcus teaches wherein the data comprises at least a first data set and a second data set, the first data set comprising a plurality of first data set portions and the second data set comprising a plurality of second data set portions, the step of storing the data on the digital video disc comprising storing the data on the disc in a manner to enable the digital video disc player to randomly select one of the first data set portions and to randomly select one of the second data set portions such that said one of the first data set portions corresponds to a first code portion of the verification code and said one of the second data set portions corresponds to a second code portion of the verification code (column 9, lines 22-67, column 10, lines 1-67, column 11, lines 1-67, column 12, lines 1-67).

Regarding claim 11, Marcus teaches wherein the first data set is different than the second data set (column 9, lines 22-67, column 10, lines 1-67, column 11, lines 1-67, column 12, lines 1-67).

Regarding claim 12, Marcus teaches wherein the step of storing the data on the digital video disc comprises storing the data on the disc in a manner to enable the digital video disc player to randomly generate the verification code such that the verification code comprises a plurality of alpha-numeric digits, the data being configured to enable the digital video disc player to randomly select each digit from a corresponding one of a plurality of sets of alpha-numeric digits (column 9, lines 22-67, column 10, lines 1-67, column 11, lines 1-67, column 12, lines 1-67).

Regarding claim 13, Marcus teaches wherein each of the plurality of sets contains a plurality of alphanumeric digits (column 9, lines 22-67, column 10, lines 1-67, column 11, lines 1-67, column 12, lines 1-67).

Regarding claim 14, Marcus teaches wherein the step of storing the data on the digital video disc comprises storing the data on the disc in a manner to enable the digital video disc player to randomly generate the verification code such that the verification code comprises a plurality of digits, the data being configured to enable the digital video disc player to randomly select the number of digits to be in the verification code (column 9, lines 22-67, column 10, lines 1-67, column 11, lines 1-67, column 12, lines 1-67).

Regarding claim 15, Marcus teaches a digital video disc having data stored thereon, the data being configured to cause a digital video disc player to randomly generate a verification code from a plurality of alternative codes (column 2, lines 1-31, column 9, lines 22-67, column 10, lines 1-67, column 11, lines 1-67, column 12, lines 1-67).

Regarding claim 16, Marcus teaches wherein the verification code comprises at least a first code portion and a second code portion (column 9, lines 22-67, column 10, lines 1-67, column 11, lines 1-67, column 12, lines 1-67).

Regarding claim 17, Marcus teaches wherein the data comprises a first data set and a second data set, the first data set comprising a plurality of first data set portions and the second data set comprising a plurality of second data set portions, the data being configured to cause the digital video disc player to randomly select one of the first data set portions and to randomly select one of the second data set portions, the first

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code portion of the verification code corresponding to said one of the first data set portions, the second code portion of the verification code corresponding to said one of the second data set portions (column 9, lines 22-67, column 10, lines 1-67, column 11, lines 1-67, column 12, lines 1-67).

Regarding claim 18, Marcus teaches wherein the first code portion comprises a first alpha-numeric digit and the second code portion comprises a second alphanumeric digit, the first digit of the verification code corresponding to said one of the first data set portions, the second digit of the verification code corresponding to said one of the second data set portions (column 9, lines 22-67, column 10, lines 1-67, column 11, lines 1-67, column 12, lines 1-67).

Regarding claim 19, Marcus teaches a method comprising: providing a digital video disc having data stored thereon configured to cause a digital video disc player to read the data in a manner sufficient to cause a video presentation to be displayed, the data further being configured to prevent the video presentation to be displayed until an access code is input into the digital video disc player (column 2, lines 1-31, column 9, lines 22-67, column 10, lines 1-67, column 11, lines 1-67, column 12, lines 1-67); using a client computer system to access a host computer system via the Internet(column 10, lines 21-67, column 11, lines 1-67); obtaining the access code from the host computer system (column 10, lines 21-67, column 11, lines 1-67); and inputting the access code into the digital video disc player in a manner to cause the video presentation to be displayed (column 10, lines 21-67, column 11, lines 1-67).

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Regarding claim 20, Marcus teaches operating the client computer system in a manner to provide client information to the host computer system, the step of providing client information to the host computer system occurring before the step of obtaining the access code from the host computer system (column 9, lines 22-67, column 10, lines 1-67, column 11, lines 1-67, column 12, lines 1-67).

Regarding claim 21, Marcus teaches a digital video disc having data stored thereon configured to cause a digital video disc player to read the data in a manner sufficient to cause a video presentation to be displayed, the data further being configured to prevent the video presentation to be displayed until an access code is input into the digital video disc player (column 2, lines 1-31, column 9, lines 22-67, column 10, lines 1-67, column 11, lines 1-67, column 12, lines 1-67).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 2 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marcus.**

Regarding claim 2, Marcus does not expressly disclose the client computer system having a digital video disc player. However, Marcus teaches playing the video on a player of the client computer system and entering a verification code (column 2, lines 1-31, column 9, lines 22-67, column 10, lines 1-67, column 11, lines 1-67, column 12, lines 1-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to play the digital video on a disc player within the client computer system. One of ordinary skill in the art would have been motivated to perform such a modification because Marcus suggests using other media and delivering methods of content (column 14, lines 35-67, column 15, lines 1-10).

Regarding claim 22, Marcus teaches wherein the access code comprises at least first and second digits and menus (column 9, lines 22-67, column 10, lines 1-67, column 11, lines 1-67, column 12, lines 1-67). Marcus does not expressly disclose the data being configured to cause a first menu to be displayed, the first menu having a first set of characters thereon, the data being configured to prompt the user to chose one of the characters from the first set of characters, the data being configured to cause a

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second menu to be displayed upon the user choosing from the first set of characters a character which corresponds to the first digit, the data being configured to cause a third menu to be displayed upon the user choosing from the first set of characters a character which fails to correspond to the first digit, the second menu having a second set of characters thereon, the data being configured to prompt the user to chose one of the characters from the second set of characters. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to generate menus in a variety of ways. One of ordinary skill in the art would have been motivated to perform such a modification because Marcus suggests using other means for users to enter verification codes (column 14, lines 35-67, column 15, lines 1-10).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent 6,263,344 to Wu et al. teach digital video disc players randomly generating numbers, US Patent Application Publication 2002/0023146 to Hiroki teaches entering codes to verify a person can view content, US Patent Application Publication 2002/0007313 to Mai et al. teaches verifying a user has viewed content and providing the user with a proof of performance of a requested action, US Patent Application Publication 2002/0154157 to Sherr et al. teaches "flexible viewing" of content.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David G. Cervetti whose telephone number is (571) 272-5861. The examiner can normally be reached on Monday-Friday 7:00 am - 5:00 pm, off on Wednesday.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DGC

CEL
Primary Examiner
AU 2136
1/13/06